



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/725,940

12/03/2003

Chiyoko Matsumi

MTS-3582US

4467

52473

7590

02/18/2009

RATNERPRESTIA

P.O. BOX 980

VALLEY FORGE, PA 19482

EXAMINER

SHIH, HAOSHIAN

ART UNIT

PAPER NUMBER

2173

MAIL DATE

DELIVERY MODE

02/18/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/725,940	Applicant(s) MATSUMI ET AL.	
	Examiner HAOSHIAN SHIH	Art Unit 2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1-15 and 19.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-15 and 19 are pending in this application and have been examined in response to application RCE filed on 01/31/2008.
2. Claim 19 is new.

Specification

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to **a single paragraph** on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The Examiner suggests the removal of the numbers referring to drawings and "[SELECTED DRAWING] FIG.1" as they are not required for US applications.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-2 and 4-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Nonaka et al. (Nonaka, US 6,614,732 B2).**

6. As to **INDEPENDENT** claim 1, Nonaka discloses a recording and reproducing system comprising:

a record medium holding (1) a plurality of data files of storing predetermined data (2) a plurality of play list files of storing a play list describing reproduction order (col.9, lines 36-45;; the hard disk stores and manages play lists that stores the “order of reproduction” of the data files), in which one or more of the plurality of data files are to be played (col.10, lines 60-63; at least **one** selected data file from the play list is to be played upon user interaction), and (3) a play list file menu file of storing ; about a hierarchical structure by which the play list files are accessible (col.3, lines 62-66; fig.11(a) and fig.11(b) indicates a structure of play lists; col.10, lines 34-40; play lists are selectable by a user);

play list file menu storing means configured to store the play list file in the play list file menu file (col.3, lines 62-66; fig.11(a) and fig.11(b) indicates a structure of play lists);

play list file menu display means configured to display to the outside play list file menu information on all or a part of the stored play list file menu (fig.12, “24”; col.10, lines 48-53; a menu of play lists are displayed);

play list file selecting means configured to select a predetermined play list file according to an instruction from the outside (fig.12 “23c”; col.10, lines 35-40; a jog dial is provided for the user to select different play lists); and

Art Unit: 2173

data reproducing means configured to reproduce the predetermined data stored by the plurality of data files respectively by using the reproduction order based on the selected play list file (fig.12, “23d”; col.9, lines 43-45).

7. As to claim 2, Nonaka discloses wherein the play list file menu display means is configured to display the displays said play list file menu information in consideration of a type of said predetermined data reproducible by the data reproducing means (col.2, lines 39-42; the “identification information” provides the necessary means for the reproducing means to function properly).

8. As to claim 4, Nonaka discloses wherein the play list file menu display means displays the play list file menu information by using predetermined text data on all or a part of the play list (fig.12, “24”, col.8, lines 2-4; text information from the play list is displayed).

9. As to **INDEPENDENT** claim 5, see rationale addressed in the rejection of claim 1 above.

10. As to claim 6, Nonaka discloses the play list file menu information on all or a part of the stored play list file menu is displayed to the outside (fig.12, “24”; col.10, lines 48-53);

Art Unit: 2173

a predetermined play list file is selected according to an instruction from the outside (fig.12, “23c”, col.10, lines 35-40), and

the predetermined data stored by the plurality of data files respectively is reproduced by using the reproduction order based on the selected play list file (fig.12, “23f”, col. 10, lines 45-47).

11. As to **INDEPENDENT** claim 7, see rationale addressed in the rejection of claim 1 above.

12. As to **INDEPENDENT** claim 8, see rationale addressed in the rejection of claim 1 above.

13. As to claim 9, see rationale addressed in the rejection of claim 6 above.

14. As to **INDEPENDENT** claim 10, see rationale addressed in the rejection of claim 1 above.

15. As to **INDEPENDENT** claim 11, see rationale addressed in the rejection of claim 1 above.

16. As to **INDEPENDENT** claim12, see rationale addressed in the rejection of claim 1 above.

As to **INDEPENDENT** claim 13, see rationale addressed in the rejection of claim 1 above.

17. As to **INDEPENDENT** claim 14, see rationale addressed in the rejection of claim 1 above.

18. As to **INDEPENDENT** claim 15, see rationale addressed in the rejection of claim 1 above.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nonaka in view of Proehl et al (Proehl, US 6,118,450).

21. As to claim 3, Nonaka does not disclose wherein the play list file menu display means is configured to display the play list file menu information by displaying at least one thumbnail image corresponding to at least one respective play list file, the displayed

Art Unit: 2173

at least one thumbnail image changing according to a state in which the play list file selecting means selects the predetermined play list file.

In the same field of endeavor, Proehl discloses using thumbnail images to represent each of the play list file corresponding to at least one respective play list file, the displayed at least one thumbnail image changing according to a state in which the play list file selecting means selects the predetermined play list file (col.8, lines 17-18, lines 30-33; corresponding thumbnails of the play list files changes according to the selection of different play list files)

It would have been obvious to one of ordinary skill in the art, having the teaching of Nonaka and Proehl before him at the time the invention was made, to modify the playlist manipulation taught by Nonaka to include thumbnail images taught by Proehl with the motivation being to present an image association with a particular genre (Proehl, col.4, lines 3-5).

22. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nonaka in view of iPod (original) User's Guide (Manual), hereafter iPod.

As to claim 19, Nonaka discloses the play lists are supported by data reproducing means (fig.12, "23d"; col.9, lines 43-45). Nonaka does not disclose wherein the play list

Art Unit: 2173

file menu display means is configured to display only the play list menu information concerning the play lists selectable through the play list file menus of lower layers.

In the same field of endeavor, iPod discloses wherein the play list file menu display means is configured to display only the play list menu information concerning the play lists selectable through the play list file menus of lower layers (pg.2, section "3 Play music."; pg.4, section "Playing a song"; a user selects the "playlists" option, the user then select a playlist file or songs in the playlist file to play).

It would have been obvious to one of ordinary skill in the art, having the teaching of Nonaka and iPod before him at the time the invention was made, to modify the the playlist manipulation taught by Nonaka to include playlist file organization via a drill down menu system taught by iPod with the motivation being to provide a compact organization system for the playlists (iPod, pg.3).

Response to Arguments

23. Applicant argues that Nonaka does not disclose a play list describing a reproduction order, in which one or more of the plurality of data files are to be played.

In response to applicant's argument, Nonaka discloses that a play list is managed and updated data files (songs) in an "order of reproduction" (col.9, lines 36-44), wherein the

Art Unit: 2173

data files are sorted in the play list based on the “order of reproduction” (fig.11(a)).

When a user selects the play list via a play-list display button, the play list redisplay/reproduces the previously recorded data files based on the “order of reproduction” (col.10, lines 40-45), **wherein through the user’s operation at least one data file (song) selected from the play list is to be played (col.10, lines 60-63).**

24. Applicant argues that Nonaka does not disclose the songs attributed to the play list are then played in the order specified in the play list.

In response to applicant’s argument, the examiner agrees that Nonaka does not disclose automatically playing all the songs in the order prescribed by the play list. However, the claimed subject matter does not clearly reflect such feature.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAOSHIAN SHIH whose telephone number is (571)270-1257. The examiner can normally be reached on m-f 0730-1700.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Kieu Vu can be reached on (571) 272-4057. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2173

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HSS

/Kieu D Vu/
Primary Examiner, Art Unit 2175